

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on April 9, 2003, and the references cited therewith.

Claims 1-2, 5-6, 14-17, 20-22, 24, 30-33, 42-43 are amended, and no claims are cancelled or added; as a result, claims 1-48 remain pending in this application.

§112 Rejection of the Claims

Claims 24 and 31 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

These claims have been corrected consistent with the Examiner's suggestions to more clearly and distinctly point out the subject matter of the present invention.

§103 Rejection of the Claims

Claim 1 was rejected under 35 USC § 103(a) as being unpatentable over Egendorf (U.S. 5,794,221).

Claims 2-48 were rejected under 35 USC § 103(a) as being unpatentable over Egendorf in view of Landry (U.S. 5,649,117).

Applicant repeats objection to using a single reference to sustain a §103 rejection, and respectfully requests that should this rejection be maintained, references showing all elements of the pending claims as well as motivation for their combination be shown as is required by MPEP §2144.03.

Applicant has amended the claims to more distinctly and clearly point out the subject matter of the present invention. Specific references to the unique context of the present transaction have been introduced or strengthened, supported by the description of the present invention in the specification. More specifically, claim limitations now more clearly recite that fees charged are associated with patent and trademark fees of a law firm. These amendments are clarify previously existing unique structural and method requirements that are used to manage this specific type of data and are recited throughout the claims and specification (*see, e.g.*, claim

l's previous discussion of a firm, a client, a matter having an identifier, a charge for fees related to the matter, etc.).

Egendorf discusses a system in which an Internet service provider bills a customer for various purchases of third-party vendor products or services, such that the provider pays the vendor the billed amount minus a transaction fee.

Egendorf does not contemplate identifying a particular matter of a client of a firm, or any other analogous system in which a regular client of an organization identifies a particular transaction by inputting matter identification. Egendorf further fails to contemplate a firm or functionally similar organization inputting the matter identification and billing information into a computer workstation, but contemplates only a client's self-initiated online transactions.

Egendorf further fails to contemplate an account maintained either by Egendorf's service provider or by any other organization analogous to the client account maintained separate from the firm in which deposits are made or that is funded to have a positive balance as recited in the claims.

Egendorf also fails to consider generating an invoice for such services, as neither the services nor account are present, but further fails to consider calculating a bill payable to the account associated with the client in such a way as the account maintains a positive balance.

Landry is relied upon in rejecting certain of the pending claims to show that receiving notice of an event relating to a matter of a client of the firm will require a second fee be paid by a due date, and issuing an invoice to ensure that the account associated with the client is prefunded to maintain a positive balance after payment of the second fee on the due date. The cited sections of Landry in fact discuss only a system in which a recurring obligation is paid from payor to payee at a regular time interval, and generation of a bill at the regular intervals for the recurring obligation amount that is used to generate TCF and EFT messages causing the funds to be transferred. Landry does not consider payment of a second fee, whether related to a matter of a client of a law firm or otherwise, and further fails to discuss maintaining an account associated with a client of a firm at a predetermined level in anticipation of upcoming fees due.

The remaining claims are believed to be in condition for allowance as dependent on an allowable base claim, or for the same reasons as discussed above. Reexamination and allowance of pending claims 1-48 is therefore respectfully requested.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, John M. Dahl, at (612) 349-9581 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743

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Date Oct. 9, 2003

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O.Box 1450, Alexandria, VA 22313-1450, on this 9 day of October, 2003.

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Name

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